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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/815,646 | 04/02/2004 | Kia Silverbrook | HYG008US | 9666 |

24011 7590 01/25/2006

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, NSW 2041
AUSTRALIA

| EXAMINER | |
|---|---|
| CAPUTO, LISA M | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2876 | |

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H'A

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/815,646 | SILVERBROOK ET AL | |
| | Examiner | Art Unit | |
| | Lisa M. Caputo | 2876 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22 and 24-47* is/are rejected.

7)☒ Claim(s) *23* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because it is an exact replication of claim 1. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The disclosure is objected to because of the following informalities:

Regarding page 40, line 29 and page 45, line 5: References to U.S. patent application numbers are blank. Please insert the correct application numbers.

Appropriate correction is required.

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Information Disclosure Statement*

4. The U.S. Patent Documents and Foreign Patent Documents on Information Disclosure Statement filed 1 November 2004 were considered, however, examiner

would like to note that the references were listed on the form without proper spacing, hence it was difficult to initial the references. Please ensure that the information disclosure statement has proper spacing so it is definitely able to be considered. It is also noted that the Non Patent Literature document was not considered since it was not available to the examiner at the time of examination.

***Claim Objections***

5. Claim 23 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

***Double Patenting***

6. Claims 1-22 and 24-47 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-47 of copending Application No. 10/815,648.

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1-22 and 24-47 of the instant application, applicants claim a method of identifying a face of an object, wherein the method includes sensing at least one coded data portion, generating, using the sensed coded data portion, indicating data indicative of the object identity and at least one of 1) a position of the sensed coded data portion, 2) a position of the sensing device relative to the face, 3) an orientation of the sensed coded data, and 4) an orientation of the sensing device relative to the face, and transferring the indicating data to a computer system to identify the face. The 10/815,648 application discloses the same method steps, but instead

claims a method for determining an orientation of a respective object. Hence, although the scope of the claims is similar, the difference between the present claimed invention and the claims of the 10/815,648 application is the intended use of the method (i.e. the method is used to identify a face of an object in the instant application and an orientation of an object in the 10/815,648 application). Thus, with respect to the above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of claims 1-47 of the 10/815,648 application as a general teaching to be able to use the method to identify the face of an object, since the identification of the face of an object is related to the orientation of an object (i.e. determining the orientation of an object allows for one to identify the face and its characteristics).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

***Allowable Subject Matter***

7. Claims 1-22 and 24-47 would be allowable upon the timely filing of a terminal disclaimer.

8. The following is a statement of reasons for the indication of allowable subject matter: The best prior art of record, U.S. Patent Application No. 2001/0035458 to Schum et al. (from hereinafter "Schum") teaches a method and apparatus for processing and determining the orientation of documents. Schum teaches that the orientation of an object is determined based on where a barcode on the object is located. However, Schum uses a document imaging system that images a document and then a system controller processes the image data to detect the presence of the barcode image, which is used to determine the orientation. Regarding the instant invention, Schum does not teach that the scanning of the barcode, and that information in the scanned barcode gives object identification data which is combined with position data and sent to a computer for the identification of the face of the object. Hence, the best prior art of record fails to specifically teach all of the steps of identifying a face of an object by sensing a code to obtain identification and location data.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 5,637,854 to Thomas which teaches an optical bar code scanner having object detection and U.S. Patent Application Publication No.

2003/0116629 to Sauve which teaches a bar code arrangement for identifying positions along an axis.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Lisa M. Caputo*** whose telephone number is **(571) 272-2388**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at **(571) 272-2398.** The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[lisa.caputo@uspto.gov]**.

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lisa M. Caputo
AU 2876
January 23, 2006